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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,343	01/31/2002	Andrew Sailus	82937SLP	3479

7590 09/26/2005

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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/062,343

Applicant(s)

SAILUS ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Response to Amendment***

1 Applicant's amendment received on 7/5/2005 is acknowledged and entered. The applicant has confirmed election of claims 1-8 and as such claims 9-20 are withdrawn. Claims 1, 4, 6, have been amended and new claims 21-23 have been added.

Election/Restrictions

2. Newly submitted amended claims 1-8 including the newly added claims 21-22 which are dependencies of claim filed on 7/5/2005 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly submitted amended claims 1-8 including the newly added claims 21-22 recite the limitation **producing an update media which is separate from the transportable transfer media and image product** which has a different utility than the earlier claimed inventions as they were directed to only producing an update media and did not require the utility of **producing an update media which is separate from the transportable transfer media and image product**. Therefore the newly submitted amended claims 1-8 including the newly added claims 21-22 are distinct from the earlier claimed inventions and would require a new and different search. This is also evident from the fact that the added new claim 23 is same as original claim 1 and is a clearly different and distinct invention when compared with the newly submitted amended claims 1-8 including the newly added claims 21-22 for the reasons explained above. Such change

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in the inventions amount to a " Shift claiming another invention after an election is once made and action given on the elected subject matter and therefore subject to " Election by Original Presentation", as analyzed above.

Kindly refer to the following MPEP excerpts for guidelines:

819 Office Generally Does Not Permit Shift:

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in **MPEP § 821.03**.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

.....

821.03 Claims for Different Invention Added After an Office Action - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting

821.03 Claims for Different Invention Added After an Office Action

Claims added by amendment following action by the examiner, **MPEP § 818.01, § 818.02(a)**, to an invention other than previously claimed, should be treated as indicated by **37 CFR 1.145**.

37 CFR 1.145 Subsequent presentation of claims for different invention.

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in **§§ 1.143 and 1.144**

The action should include form paragraph 8.04.

¶ 8.04 Election by Original Presentation.....

.....
An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly submitted amended claims 1-8 including the newly added claims 21-22 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

In the amendment filed on 5/4/2005 the remaining claim 23 is readable on the elected invention and would be further examined on merits.

Response to Arguments

3.1. Applicant's arguments with respect to the newly submitted amended claims 1-8 including the newly added claims 21-22 have been considered but are moot in view of they being withdrawn from consideration as being directed to a non-elected invention for reasons given above.

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3.2. Applicant's arguments filed 7/5/2005 with respect to claim 23, see Remarks, pages 10-11 have been fully considered but are moot in view of the new ground(s) of rejection, that is being rejected under 35 USC 102 (a) as being anticipated by the earlier cited reference CeWe because it also teaches producing an update media in the form of a finished CD, see page 2, 2nd paragraph and sending it with the paper prints, that is the image product to the retail location from where the user can pick it up.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4.1. Claim 23 is rejected under 35 U.S.C. 102(e) as being anticipated by CeWe.

Regarding claim 23 CeWe discloses an order processing method, comprising the steps of:

generating an order request for an image product using an imaging device located at a retail location, the order request associated with at least one digital image accessed by a user at the imaging device, transferring the at least one digital image to a transportable transfer media, transporting the transportable transfer media from the retail location to a service fulfillment location located remotely from the retail location,

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fulfilling the order request to produce the image product at the service fulfillment location, and transporting the image product to the retail location (see at least " *With its DigiFilm terminals, CeWe Color now has a solution to all these problems. "The terminals, which are available in two versions (with and without a monitor), are installed at the photo retailers and make it possible for the customer with a digital order to proceed in exactly the same way he did with an analog order," The customer takes his memory card to the retail store. where the image data are recorded immediately onto a CD in the DigiFilm station. This process takes about 1.5 minutes. The DigiFilm CD takes not only the image data from the memory card, but also an order file with the order data for printing in the lab.....The finished CD is - like conventional film- inserted in the order envelope by the retailer; two days later, the finished job (one paper print per picture, plus a CD and Index print) can be picked up. It means digital photographers can get their prints just as quickly and easily as analog photographers.....* " . Note: The user transfers the digital image from the memory card using the DigiFilm terminal [corresponds to the imaging device located at the retail location] to a CD [transportable transfer media]; the CD is transported to the Lab [service fulfillment location remotely located from the retail location; Lab fulfils the order producing the image products and update media and transports the update media and image products back to the retail station for customer pick up.). CeWe also teaches producing an update media in the form of a finished CD, see page 2, 2nd paragraph and sending it with the paper prints, that is the image product to the retail location from where the user can pick it up.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,157,435 to Slater et al. teaches a method and system in the same field of endeavor, that is of the instant application providing a customer certificate which conveys promotional material based upon the data identified from the images of the user (see at least col.5, line 45-col.6, line 46 and col.15, line 35-col.17, line 20).

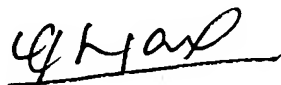
(ii) US Patent 6,943,866 to Redd et al. discloses generating an order request for an image product using an imaging device located at a retail location, the order request associated with at least one digital image accessed by a user at the imaging device, transferring the at least one digital image to a transportable transfer media, transmitting the digital images for processing to a photo-finisher who can arrange to distribute them to various geographical areas as per requirement (see at least col.13, line 22-col.15, line 5).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
September 19, 2005